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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

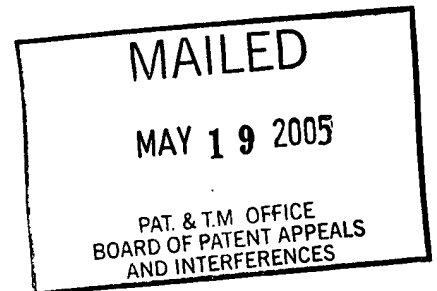
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN KIKINIS

Appeal No. 2005-0508
Application No. 09/024,923

ON BRIEF



Before THOMAS, HAIRSTON and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4-7, 10-13, 15 and 18, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for converting telephony calls between Connection Oriented/Switched Telephony (COST) calls and Internet Protocol

Network Telephony (IPNT) calls in order to permit live conversation between a user on a COST telephone connected to the COST network and a user on an IPNT terminal connected to the Internet.

Representative claim 1 is reproduced as follows:

1. A computerized telephony bridge unit, comprising:

a trunk-line port and associated circuitry for receiving and placing Connection Oriented/Switched Telephony (COST) telephone calls on a COST network;

a data network port and associated circuitry for receiving and placing Internet Protocol Telephony Network (IPNT) calls on the Internet;

conversion circuitry for converting data representing calls dynamically between IPNT and COST telephone calls and

a digitally-stored look-up table relating COST telephone numbers to IP addresses;

characterized in that control routines functioning as part of the bridge unit receive a first incoming call from one of the COST and Internet networks, extract specific data encoded into the incoming call, either COST or IPNT, and use the extracted data to access the look-up table to determine an associated COST telephone number or IP address, and use the associated COST telephone number or IP address to place a call associated with the received call on the network other than the network on which the call is received, and dynamically convert data between the associated calls, and the dynamic conversion of data enables two people to engage in a live conversation even though one person is on the Internet and the other is on a COST network.

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The examiner relies on the following references:

Iwami et al. (Iwami)	5,604,737	Feb. 18, 1997
Chang et al. (Chang)	6,198,738	Mar. 06, 2001
		(filed Apr. 16, 1997)

Claims 1, 4-7, 10-13, 15 and 18 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Iwami in view of Chang.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in

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the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group (brief, page 9). Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some

teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this

decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)(2004)).

With respect to representative independent claim 1, the examiner essentially finds that Iwami teaches the claimed invention except that Iwami does not specifically disclose that the LAN network includes the Internet. Since Iwami discloses that the LAN can run TCP/IP or UDP/IP protocols, the examiner finds that the LAN could be the Internet. The examiner also cites Chang as teaching the completion of calls between a computer and a telephone. The examiner finds that it would also have been obvious to the artisan to include the Internet as taught by Chang with the method and system of Iwami (answer, pages 3-4).

Appellant argues that the operation taught by Iwami does not meet the claimed "extracting specific data encoded into the incoming call either COST or IPNT, and using the extracted data to access the look-up table to determine an associated COST number or IP address as claimed" (brief, page 10). Appellant also argues that Iwami fails to teach processing an incoming Internet call and only deals with incoming COST calls. Appellant

also argues that the motivation for combining the teachings of Chang with Iwami comes from appellant's own disclosure (id., pages 10-12).

The examiner responds that it would not be possible for the communication server to know which telephone to send the call setting request to unless the server decoded information received in the voice communication request to obtain the correct telephone number. In other words, it is the examiner's position that the called telephone number itself constitutes data which has been encoded into the incoming call. The examiner also responds that even though claim 1 recites incoming COST or IPNT calls in the alternative, Iwami does teach the processing of incoming Internet calls in Figure 11 and the use of a look-up table in Figure 18. Finally, the examiner explains how the invention of claim 1 is derived from the teachings of Iwami and Chang and not from appellant's own disclosure (answer, pages 5-8).

We will sustain the examiner's rejection of all the claims on appeal for essentially the reasons argued by the examiner in the answer. Specifically, we agree with the examiner that Iwami clearly teaches connecting calls from a telephone to a computer or from a computer to a telephone. We also agree with

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the examiner that any call made includes the called telephone number encoded within the call even if the encoding constitutes nothing more than the telephone number itself or the Internet address of the computer being called. As noted by the examiner, the term "encoded" is broad enough to read on almost any information such as the telephone number. It is clear that Iwami uses the extracted information, that is, the telephone number, to access a look-up table as claimed (see Figure 18). Regarding the motivation to combine, Chang is only cited to teach that it was known to communicate telephone calls between a standard telephone and a computer on the Internet. We agree with the examiner that it would have been obvious to the artisan to replace the generic LAN taught by Iwami with the Internet in order to provide a wider network for the system of Iwami to be used.

In summary, we find that the examiner has established a prima facie case of the obviousness of the claims on appeal, and appellant's arguments have not persuaded us that the rejection is in error. Therefore, the decision of the examiner rejecting claims 1, 4-7, 10-13, 15 and 18 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

Gerry Smith
JERRY SMITH
Administrative Patent Judge

BOARD OF PATENT
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